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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,125	10/31/2003	Julie A. Gannon	03-364	4999

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EXAMINER
CERVETTI, DAVID GARCIA

ART UNIT	PAPER NUMBER
2136	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/699,125	GANNON ET AL.
	Examiner	Art Unit	
	David G. Cervetti	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>31 October 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>07 September 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>10/31/03</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-51 are pending and have been examined.

Claim Objections

2.   Claim 9 is objected to because of the following informalities: "claim 9". Examiner

has interpreted claim 9 to be dependent from independent claim 1. Appropriate

correction is required.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claims 25 and 45 is rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

        Claim 25 recites the limitation "said plurality of processors". There is insufficient

antecedent basis for this limitation in the claim.

        Claim 45 recites the limitation "said remote machine". There is insufficient

antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6.   **Claims 1-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Zhang et al. (US Patent 6,966,000, hereinafter Zhang).**

Regarding claim 1, Zhang teaches

- a method of enabling a software option located on a remote machine **(abstract)**, comprising the steps of:

- receiving a request to enable said software option **(abstract)**;

- authorizing said enablement **(abstract)**;

- delivering a first enabling signal to an intermediary **(col. 5, lines 1-45)**; and

- delivering a second enabling signal to said machine in response to said first enabling signal **(col. 5, lines 45-67)**.

Regarding claim 24, Zhang teaches

- a method of enabling a software option located on a remote machine **(abstract)**, comprising the steps of:

- receiving a request to enable said software option **(abstract)**;

- authorizing said request **(abstract)**;

- delivering an enabling signal to said remote machine **(col. 5, lines 1-45)**;

- distributing at least a portion of said enabling signal to a plurality of controllers located on said remote machine **(col. 5, lines 45-67)**.

Regarding claim 27, Zhang teaches

- a method of enabling a software option located on a replacement processor of a remote machine **(abstract)**, comprising the steps of:

- identifying a failed processor associated with said replacement processor **(col. 6, lines 7-40)**;

- receiving a request to enable said software option **(abstract)**;

- authorizing said request in response to said identified failed processor **(abstract)**; and

- delivering an enabling signal to said replacement processor in response to said authorization **(col. 5, lines 1-45)**.

Regarding claim 30, Zhang teaches

- a method of providing an entitlement for an enabled software option located on a remote machine **(abstract)**, comprising the steps of:

- receiving a request to disable said software option **(col. 6, lines 7-40)**;

- disabling said software option **(col. 6, lines 7-40)**;

- receiving a disabled characteristic associated with said software option **(col. 6, lines 7-40)**;

- establishing an entitlement in response to said disabled characteristic **(col. 7, lines 1-47)**.

Regarding claim 39, Zhang teaches

- a method of enabling a software option located on a remote machine **(abstract)**, comprising the steps of:

- receiving a request to enable said software option **(abstract)**;

- enabling said software option during a trial period **(col. 7, lines 20-47)**;

- notifying a user with respect to an expiration of said trial period **(col. 7, lines 20-47)**;

- receiving a request to enable said software option in response to said notification; authorizing said request **(col. 7, lines 20-47)**;

- delivering an enabling signal to said remote machine **(col. 7, lines 20-47)**.

Regarding claim 43, Zhang teaches

- a method of disabling a software option located on a remote machine **(abstract)**, comprising the steps of:

- receiving a request to disable said software option **(col. 6, lines 7-40)**;

- disabling said software option **(col. 6, lines 7-40)**; and

- receiving a disabled characteristic associated with said software option **(col. 7, lines 1-47)**.

Regarding claim 44, Zhang teaches

- a method of enabling a software option located on a remote customer machine **(abstract)**, comprising the steps of:

- receiving a request by a manufacturer from a dealer to enable said software option **(col. 7, lines 20-47)**;

- authorizing said request in response to a dealer characteristic and a machine characteristic **(col. 7, lines 20-47)**; and

- delivering an enabling signal to said remote machine **(col. 7, lines 20-47)**.

Regarding claim 49, Zhang teaches

- a method of enabling a software option located on a remote machine **(abstract)**, comprising the steps of:

- establishing a machine specific configuration **(col. 4, lines 23-57)**;

- generating a request to enable said software option in response to said machine specific configuration **(col. 4, lines 23-57, col. 5, lines 45-67)**,

- said request being authorized at a remote location **(col. 7, lines 20-47)**;

- receiving an enabling signal at said machine in response to said authorization **(col. 7, lines 20-47)**.

Regarding claim 50, Zhang teaches

- a method of enabling a software option located on a first machine **(abstract)**, comprising the steps of:

- establishing a need for said software option on said first machine **(col. 7, lines 20-47)**;

- delivering a request for said software option to a second machine **(col. 7, lines 20-47)**;

- disabling said software option on said second machine in response to said request **(col. 6, lines 7-40)**;

- generating an enabling signal in response to said disablement **(col. 4, lines 23-57, col. 5, lines 45-67)**; and

-     enabling said software option on said first machine in response to said

enabling signal **(col. 7, lines 20-47)**.

Regarding claim 51, Zhang teaches

-     a system configured to enabling a software option located on a remote

machine **(abstract)**, comprising;

-     a controller located on said remote machine **(col. 3, lines 40-67)**,

-     said controller being configured to generate a request to enable said

software option **(col. 3, lines 40-67)**;

-     a remote facility configured to receive said request, authorize said

request **(col. 7, lines 20-47)**and

-     generate a first enabling signal **(col. 5, lines 1-45)**; and

-     an intermediary configured to receive said first enabling signal,

authenticate said signal, and responsively deliver a second enabling

signal to said machine in response to said first enabling signal **(col. 5,

lines 1-45)**.

Regarding claim 2, Zhang teaches wherein said intermediary authenticates said

enabling signal **(col. 5, lines 1-45)**.

Regarding claim 3, Zhang teaches wherein the step of delivering said second

signal further comprises the step of delivering said second signal in response to said

authenticating said first enabling signal **(col. 6, lines 7-40)**.

Regarding claim 4, Zhang teaches establishing a machine specific configuration; and generating said software option request in response to said machine specific configuration **(col. 6, lines 7-40)**.

Regarding claim 5, Zhang teaches delivering said second enabling signal to a controller located on said machine **(col. 5, lines 45-67)**.

Regarding claim 6, Zhang teaches wherein said request is generated by a software program needing said software option **(abstract)**.

Regarding claim 7, Zhang teaches wherein the step of delivering said second signal further comprises the step of delivering said second signal to a plurality of controllers located on said remote machine **(col. 5, lines 45-67)**.

Regarding claim 8, Zhang teaches initiating a billing process in response to said authorization **(col. 8, lines 1-23)**.

Regarding claim 9, Zhang teaches determining if one of an entitlement and a credit is available in response to said billing process initiation **(col. 8, lines 1-23)**.

Regarding claim 10, Zhang teaches authorizing said enablement in response to an entitlement associated with said software option **(col. 8, lines 1-23)**.

Regarding claim 11, Zhang teaches wherein said intermediary is a gateway network **(col. 5, lines 1-45)**.

Regarding claim 12, Zhang teaches generating said request in response to a controller failing **(col. 6, lines 7-40)**.

Regarding claim 13, Zhang teaches wherein said request includes a failed controller characteristic and a replacement controller characteristic **(col. 6, lines 7-40)**.

Regarding claim 14, Zhang teaches wherein the step of authorizing said enablement further includes the step of authorizing said enablement for a time period **(col. 5, lines 45-67)**.

Regarding claim 15, Zhang teaches wherein the step of receiving said request further comprises the step of receiving said request from a dealer associated with said machine **(col. 5, lines 45-67)**.

Regarding claim 16, Zhang teaches wherein the step of authorizing said enablement further includes the step of authorizing said enablement by a manufacturer associated with said machine **(col. 6, lines 7-40)**.

Regarding claim 17, Zhang teaches generating a request to enable said software option by a first machine **(col. 6, lines 7-40)**.

Regarding claim 18, Zhang teaches disabling said software option on a second machine in response to said enablement authorization **(col. 8, lines 1-41)**.

Regarding claim 19, Zhang teaches wherein the step of delivering said first enabling signal further comprises the step of delivering said first enabling signal in response to said disabling of said software option **(col. 8, lines 1-41)**.

Regarding claim 20, Zhang teaches scheduling a delivery of said first enabling signal **(col. 7, lines 20-67)**.

Regarding claim 21, Zhang teaches wherein the step of scheduling said delivery further comprises the step of scheduling said delivery in response to a priority of said request **(col. 8, lines 1-24)**.

Regarding claim 22, Zhang teaches wherein the step of scheduling said delivery

further comprises the step of scheduling said delivery in response to a priority of said

request and a priority associated with a current use of said software option **(col. 8, lines

1-41)**.

Regarding claim 23, Zhang teaches delivering a notification to said first

machine, said notification including an indication of when said request may be fulfilled

(col. 5, lines 45-67).

Regarding claim 25, Zhang teaches wherein said software option is associated

with said plurality of processors **(col. 4, lines 1-35)**.

Regarding claim 26, Zhang teaches wherein the step of delivering an enabling

signal to said remote machine further comprises the step of delivering said enabling

signal to a primary processor, and further wherein said primary processor delivers a

second enabling signal to said at least one other processor **(col. 7, lines 20-47)**.

Regarding claim 28, Zhang teaches wherein said request includes at least one

of a failed controller identifier and a replacement controller identifier **(col. 6, lines 7-40)**.

Regarding claim 29, Zhang teaches wherein the step of authorizing said request

includes the steps of: authenticating said failed controller identifier and said replacement

controller identifier, and confirming the requested software option was enabled on said

failed controller **(col. 5, lines 1-45, col. 6, lines 7-40)**.

Regarding claim 31, Zhang teaches wherein said entitlement is associated with

said disabled software option **(col. 8, lines 1-45)**.

Regarding claim 32, Zhang teaches authenticating said disabled characteristic **(col. 6, lines 40-67)**.

Regarding claim 33, Zhang teaches wherein the step of establishing an entitlement further comprises the step of establishing said entitlement in response to said authentication **(col. 6, lines 40-67)**.

Regarding claim 34, Zhang teaches receiving a request to enable a software option on a second machine; and authorizing said request in response to said entitlement **(col. 6, lines 40-67)**.

Regarding claim 35, Zhang teaches authenticating said request in response to a controller characteristic and a software option status; and generating a disable signal in response to said authentication **(col. 6, lines 40-67)**.

Regarding claim 36, Zhang teaches wherein the step of disabling said software option further comprises the step of disabling said software option in response to said disable signal and a machine status **(col. 6, lines 40-67)**.

Regarding claim 37, Zhang teaches wherein said machine status includes one of power up and power down **(col. 6, lines 40-67)**.

Regarding claim 38, Zhang teaches wherein said machine status includes an implement status **(col. 7, lines 27-67)**.

Regarding claim 40, Zhang teaches generating a disable signal in response to said trial period expiration **(col. 7, lines 20-47)**.

Regarding claim 41, Zhang teaches disabling said software option in response to said disable signal and a machine status **(col. 6, lines 40-67)**.

Regarding claim 42, Zhang teaches wherein said machine status includes one

of power up and off **(col. 6, lines 40-67)**.

Regarding claim 45, Zhang teaches wherein the step of delivering an enabling

signal to said remote machine further comprises the steps of: delivering an enabling

signal to said dealer in response to said authorization; and delivering said enabling

signal to said remote machine in response to said dealer receipt **(col. 7, lines 20-47)**.

Regarding claim 46, Zhang teaches wherein said dealer characteristic includes

at least one of a service tool identifier, a service representative identifier, a dealer

identifier, and a cross reference identifier of said dealer and said customer **(col. 7, lines**

20-47).

Regarding claim 47, Zhang teaches wherein said machine characteristic

includes at least one of a software option identifier, a processor identifier, and a

configuration identifier **(col. 7, lines 28-67)**.

Regarding claim 48, Zhang teaches wherein said step of authorization further

includes the step of authorizing said request in response to a machine characteristic, a

dealer characteristic, and a user characteristic **(col. 7, lines 20-47)**.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Savitzky (US Patent 6,260,076) teaches a method for

communicating with a plurality of remote machines, of a plurality of machine types,

using a computer system having a memory, includes the steps of constructing within the

memory a first plurality of software objects, the first plurality of software objects

describing services for one of the plurality of remote machines, establishing

communications with the one remote machine, and invoking operations on the one

remote machine in response to requests described by services of the first plurality of

software objects. Zhang (US Patent 6,829,704) teaches a method to enable software

options is disclosed that includes receiving an electronic request for activation of an

inactive option in memory of a device located remotely from a centralized facility. The

method further determines whether to activate the inactive option in response to the

electronic request based on whether a set of criteria has been satisfied. The criteria is

defined at the centralized facility and can include a number of parameters, including a

user identifier, a system identifier, a host identifier, an option identifier, modality, and a

period-of-use identifier. If the set of criteria is unsatisfied, use of the inactive option is

denied. If the set of criteria is satisfied, the method generates an activation key

configured to permit use of the inactive option upon installation of the key in the device,

and further sends the activation key from the centralized facility to the device, wherein

the activation key is automatically installed upon initialization of the device.

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to David G. Cervetti whose telephone number is (571)272-

5861. The examiner can normally be reached on Monday-Tuesday and Thursday-

Friday.

9.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Nasser Moazzami can be reached on (571)272-4195. The fax phone
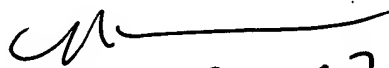
number for the organization where this application or proceeding is assigned is 571-
273-8300.

10.   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DGC

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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

3/30/07